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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/810,610	03/29/2004	Brett Allison Taylor	104558-300	9705

28765 7590 03/17/2008  
WINSTON & STRAWN LLP  
PATENT DEPARTMENT  
1700 K STREET, N.W.  
WASHINGTON, DC 20006

EXAMINER
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PRONE, CHRISTOPHER D

ART UNIT	PAPER NUMBER
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3738

MAIL DATE	DELIVERY MODE
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03/17/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/810,610	<b>Applicant(s)</b> TAYLOR, BRETT ALLISON	
	<b>Examiner</b> CHRISTOPHER D. PRONE	<b>Art Unit</b> 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-34 and 36-46 is/are pending in the application.
- 4a) Of the above claim(s) 8, 12-25, 30, 32, 34 and 41-45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-11, 26-29, 31, 33, 36-40 and 46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

In response to the applicant's arguments claim 39 is rejoined and fully examined for patentability.

However upon further review claims 8, 12-25, and 41 are withdrawn for being directed to nonelected species A because it requires that the second articulating portion is mounted to the second contacting member. To correct this applicant is advised to remove this requirement from claims 8 and 12, upon doing so these newly withdrawn claims will be rejoined.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

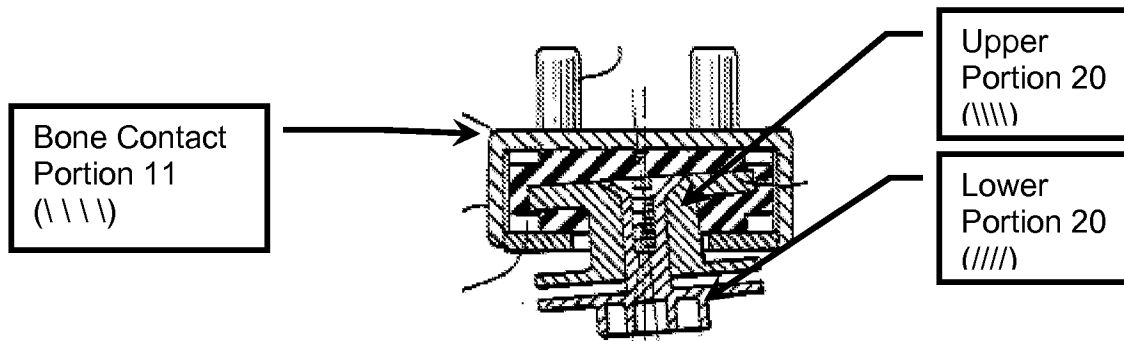
(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7, 9-11, 21, 22, 25, 40 and 46, are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 4,932,975 Main et al.

Main discloses the same invention being a arthroplasty prosthesis comprising a first upper bone contact member 11, second lower bone contact member 11, a central articulation member that allows for pivotal and translational movement of each contact independently comprising a first articulation portion 20 that is in sliding contact with a

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second articulation portion, a body prosthetic portion 22. The second articulation portion slides within the first portion and is held there by a screw (shown below).



Claims 26-29, 31, and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 5,258,031 Salib et al.

Salib discloses the same invention being an arthroplasty prosthesis comprising a first upper bone contact member 20, second lower bone contact member 22, a central articulation members 24 and 44, and diagonally orientated first and second fastener mount holes 40.

Claim 36-38 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 2002/0183761 A1 Johnson et al.

Johnson discloses the same invention being an arthroplasty prosthesis comprising a first upper bone contact member 198, second lower bone contact member 200, a central articulation members (plates between members 198 and 200) that allow the vertebra to pivot and articulate, wherein the members are made from peek [0097],

can comprise radiopaque markers [0097] and can deliver a biologically active substance to the implant site [0097].

Claim 39 is rejected under 35 U.S.C. 102(b) as being anticipated by USPN 6,296,643 B1 Hopf et al.

Hopf discloses the same invention being an arthroplasty prosthesis comprising a upper bone contact member 11, second lower bone contact member (bottom anchor figure 6a), a central articulation member (middle anchor figure 6a) that have comprise holes for receiving suture 38.

### ***Response to Arguments***

Applicant's arguments filed 1/14/08 have been fully considered but are moot in view of new rejections except those arguments directed towards claims 26-29, 31, and 33 rejected under 35 U.S.C. 102(b) as being anticipated by USPN 5,258,031 Salib. The applicant arguments are all directed towards intended use. The device of Salib is fully capable of being positioned so that the device will meet the intended use.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher D. Prone whose telephone number is (571) 272-6085. The examiner can normally be reached on Monday through Fri 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher D Prone  
Examiner  
Art Unit 3738

/Christopher D Prone/  
Examiner, Art Unit 3738

/Corrine M McDermott/  
Supervisory Patent Examiner, Art Unit 3738